

REMARKS

Claims 1-6, 8-10 and 12 are pending in this application. By this Amendment, claims 1, 4, 5 and 9 are amended, as is the specification and Fig. 1. Claim 12 is added. The amendments and added claim introduce no new matter because they are supported by the specification and claims as originally filed. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Williams in the August 23, 2005 telephone interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

I. Formal Matters

A. The Office Action, on page 6, indicates that claim 6 recites allowable subject matter. Applicants appreciate this indication of allowability. However, Applicants respectfully submit that claim 1 from which claim 6 depends is also allowable, for any or all of the reasons indicated below.

The Office Action, on page 2, objects to the disclosure and figures because, the Office Action alleges, the amendments to the specification and figures, which were included as part of Applicants' Amendment After Final Rejection, filed on July 22, 2004, introduce new matter.

At the outset, Applicants note that after repeated attempts to contact Examiner Thompson, the Examiner previously responsible for this application between June 29, 2004 and July 12, 2004, Applicants' representative contacted Supervisory Patent Examiner Casler in an attempt to resolve a number of outstanding issues regarding the then-pending Office Action.

After Examiner Casler reviewed the application, Applicants' representative discussed amendments to the figures and specific features which could be added to independent claim 1 in order to overcome the previously applied prior art rejections under 35 U.S.C. §§102(b) and 103(a) without introducing new matter. The amendments to the drawings and the claims

included in the July 22 Amendment were undertaken in light of the discussion between Applicants' representative and Supervisory Patent Examiner Casler, who agreed that they did not introduce new matter. As such, Applicants respectfully submit that, contrary to the assertions in the Office Action, Figs. 1-3, the first amendment to the specification, and the amendments to claim 1 do not introduce new matter, and that the current rejections in this regard violate the Patent Office's policy of giving full faith and credit to a prior Examiner's action.

In an effort to expedite further prosecution of this application, however, Applicants amend Fig. 1 to remove what the Office Action asserts is allegedly new matter, and the specification and claim 1 are amended to remove reference to the barrier being "solid." Nonetheless, Applicants reserve the right to later, if necessary, re-insert "solid," because it is inherently supported by the original disclosure of the examples of aluminum and steel.

Regarding the objections to Figs. 2 and 3, Applicants produced these figures to depict, in an exemplary manner, the features recited in claims 4-6, as originally filed, in response to a previous Office Action. This Office Action indicates that Figs. 2 and 3 introduce new matter because while the original disclosure teaches or mentions the depicted features, the original disclosure allegedly does not support the configurations shown in the figures. Applicants respectfully submit that the exemplary embodiments depicted in Figs. 2 and 3 are illustrative of the features recited in the claims and are not intended to depict any specific configurations beyond the features, as recited in the claims. These drawings (1) were provided in response to an objection raised under 37 C.F.R. §1.83 in a previous Office Action, (2) meet the requirements of 37 C.F.R. §1.83. These drawings are not submitted to overcome any insufficiency of the specification due to lack of enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim in violation of 37 C.F.R. §1.81(c).

With regard to the objection to claim 1 enumerated in paragraph 5 on page 3 of the Office Action where it is asserted that the barrier means remains "trapped in the syringe without any possibility of being expelled" is not supported by the original disclosure, this conclusion is incorrect. On page 10, in the paragraph beginning at line 8, the disclosure, as originally filed, states "(a)dvantageously, under the effect of the pyrotechnic charge, the barrier, although having been deformed, remains fixed in the syringe at its original position. According to another embodiment of the invention, when confronted by the same stress, the barrier is displaced but remains trapped in the syringe without any possibility of being expelled" (emphasis added).

Based on the foregoing, Applicants respectfully request withdrawal of the objections to the specification for allegedly introducing new matter.

Applicants' representative discussed each of the above issues with Examiner Williams during the August 23 telephone interview. The Examiner indicated her understanding of all of the issues raised and her willingness to review the issues in full when a formal reply was submitted. Examiner Williams maintained her position that Figs. 2 and 3 allegedly introduce new matter. The Examiner was unable to offer any suggestions regarding resolution of this matter. Applicants believe that the issues raised are adequately addressed by Applicants' express disclaimer of any specific configuration regarding the depicted features.

B. The Office Action, on page 3, objects to claims 4 and 5 because of informalities.
Claims 4 and 5 are amended to obviate the objection. Withdrawal of the objection to claims 4 and 5 is respectfully requested.

C. The Office Action, on pages 3 and 4, rejects claim 1 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action asserts that claim 1 recites new matter as to the barrier being "solid" and remaining "trapped in the syringe without any possibility of being expelled." Claim 1 is

amended to remove any reference to the barrier being "solid." As indicated above, the feature "trapped in the syringe without any possibility of being expelled" is specifically discussed in the disclosure at page 10.

Accordingly, reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §112, first paragraph, are respectfully requested.

D. The Office Action, on page 4, rejects claim 9 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 9 is amended to obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. §112, second paragraph, are respectfully requested.

II. Response to Prior Art Rejections

The Office Action, on page 5, rejects claims 1-5, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,737,946 to Hein. The Office Action, on page 5, rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over Hein. These rejections are respectfully traversed.

Hein teaches an apparatus for hypodermically injecting medicaments, which expels the medicaments in a fine stream and at such velocities that a hypodermic injection is achieved without the use of a skin penetrating needle (col. 1, lines 15-19). Hein does not disclose a resistant barrier which ensures good propagation of shock wave, as is recited in independent claim 1. The Office Action asserts that element 83 of Hein corresponds to the claimed barrier. However, the barrier 83 is made of rubber. Rubber would tend to dampen or eliminate any shock wave, rather than ensuring good propagation of the shock wave. Therefore, element 83 of Hein clearly does not correspond to the barrier in claim 1.

Additionally, the Office Action offers no evidence that the Hein device generates a shock wave. There certainly is no express disclosure of such, and the Examiner is reminded of the Patent Office's burden regarding inherency, set forth in MPEP §2112.

Additionally, the Hein device clearly does not achieve an advantage of the invention of claim 1, which is that a plane shock wave is produced on the upstream face of the fixed barrier which propagates through the barrier and violently ejects the active principle from cavities where it is arranged. Unexpectedly, the active principle thus accelerated at very high speed is able to regroup in the form of a central jet of small diameter which will then penetrate into the skin of the subject (see Applicants' specification at page 4, lines 11-26).

For at least this reason, Applicants respectfully submit that Hein does not teach, nor would it have suggested, the combination of all of the features recited in independent claim 1. Further, dependent claims 2-5 and 8-10 are also neither taught, nor would they have been suggested, by Hein for at least the respective dependence of these claims on independent claim 1, as well as for the separately patentable subject matter which each of these claims recites.

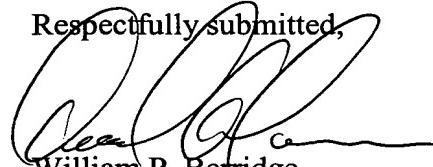
For example, regarding claim 9, Applicants respectfully disagree that Hein discloses the length of an application guide being between 2 and 5 times the diameter of the barrier. Rather, the length of the application guide in Hein (*i.e.*, element 17) appears to be about equal to the diameter of the barrier.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-5 and 8-10 under 35 U.S.C. §§102(b) and 103(a) as being anticipated by, or unpatentable over, Hein are respectfully requested.

III. Conclusion

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-5, 8-10, and 12 in addition to the indicated allowable subject matter of claim 6, are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

William P. Berridge
Registration No. 30,024

Daniel A. Tanner, III
Registration No. 54,734

WPB:DAT/fpw

Attachment:

Replacement Drawing Sheet (Fig. 1)

Date: September 14, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE
AUTHORIZATION
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 15-0461

Amendments to the Drawings:

The attached replacement drawing sheet makes changes to Fig. 1, and replaces the original sheet with Fig. 1.

Attachment: Replacement Sheet